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In re Application of : DECISION ON
HAUSER :
Application No.: 09/965,050 :
Int. Filing Date: 27 September 2001 : PETITION
Attorney's Docket No.: 2001-6010-RA :
For: 3-DIMENSIONAL MAT-SYSTEM FOR POSITIONING : UNDER 37 CFR 1.181
STAGGERED ARRANGEMENT AND VARIATION OF :
AGGREGATE IN CEMENT-BONDED STRUCTURES :

This is in response to the petition under 37 CFR 1.181, filed 25 December 2002, requesting that the above identified application be treated as a submission under 35 U.S.C. 371 as a national stage application of international application PCT/IB00/01369.

In a decision dated 06 August 2002, applicant's petition to revive PCT/IB00/01369 was granted for the purposes of establishing continuity with U.S. application 09/965,050, which was considered as a filing under 35 U.S.C. 111(a). In the 25 December 2002, applicant has stated that "this application was filed as a submission to enter the national stage under 35 U.S.C. 371, not as a continuation." Applicant has requested a further explanation regarding the status of this application and the priority.

On 27 September 2001, applicant filed a "UTILITY PATENT APPLICATION TRANSMITTAL" (Form PTO/SB/05) accompanied by, inter alia, filing fee, specification, claims and drawings. On 24 October 2001, applicant filed a petition to revive the international application and a transmittal letter (Form PTO-1390) for entry into the national stage in the United States.

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The "UTILITY PATENT APPLICATION TRANSMITTAL" (Form PTO/SB/05) filed on September 27, 2001 indicated that the application was a filing of a new nonprovisional application under 37 CFR 1.53(b). The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 111(a). Note that the transmittal letter has the statement "(Only for new nonprovisional applications under 37 CFR 1.53(b))." The filing under 37 CFR 1.53(b) is only directed to application filed under 35 U.S.C. 111(a). Additionally, applicant filed on September 27, 2001 a letter that stated, "Please find enclosed for filing the above-referenced non-provisional patent application, a submission to enter the national stage under 35 U.S.C. 371...." The declaration filed on September 27, 2001 is directed to the specification of which was filed as PCT international application Number PCT/IB00/01369 on September 26, 2000. As indicated above the declaration is an indication that the application was being filed under 35 U.S.C. 371. However, applicant's reference in the declaration to the PCT application and letter is inconsistent with the transmittal letter filed September 27, 2001 and contradicts the request in the transmittal letter (Form PTO/SB/05) to file under 35 U.S.C. 111(a). Since applicant gave conflicting instructions, the papers were properly considered as having been filed under 35 U.S.C. 111(a) with a filing date of September 27, 2001. The later filed papers cannot change the status of the original filing.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 09/965,050) and the international application (PCT/IB00/01369) designating the United States were copending on 27 September 2001. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is a continuation of international application PCT/IB00/01369, filed 26 September 2000, which designated the United States and is now abandoned." In addition, since the application was filed after November 29, 2000, applicant must file a surcharge and petition under 37 CFR 1.78(a)(3) for an unintentionally delayed claim under 35 U.S.C. 365(c) for the benefit of a prior international application.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

The petition under 37 CFR 1.181 is DISMISSED without prejudice.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

This application is being returned to Tech Center 3600.



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